APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/483,183	TRETTER ET AL.
	Examiner	Art Unit	
	Christopher J. Brown	2134	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>20 July 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-31</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-31</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 7/20/2005 have been fully considered but they are not persuasive.

The applicant's argument with respect to Claim 12 is that Debry US Boyles US 6,738,901 does not teach a printer establishing its printer identity "directly" with a server. The examiner could not find support for the amendment in the instant specification. The amendment appears to be new matter (see rejection below). In addition the examiner would argue that the key used to establish identity is being sent "directly" from the printer to the print server, thus "directly" establishing its print identity.

The applicant argues with respect to claims 1, and 19 that Debry does not teach changing the identity of a printer or using the smart card. The examiner admits that Debry does not teach use of a smart card and thus relies on Mandelbaum US 5,552,897 instead. However the examiner argues that Debry does teach establishing an identity between the printer and server with the "Will Call certificate". Debry teaches as part of the will call certificate a key is included. This key also relates to the user. Thus the user and printer establish an identity with the server. The applicant argues that Debry does not teach or suggest a printer having no identity prior to using a smart card. Support for this

amendment, only in Claim 1, and not recited in claim 19 cannot be found in the instant

specification. Please see Rejection below.

The applicant argues that because Mandelbaum does not teach using a smart card to

establish an identity that there is no motivation for use with Derby. The examiner

counters that both references are of analogous arts (printers) and that a smart card for use

with a printer provides portability, and in certain areas enhances security. It is also

widely taught that smart cards are capable of containing and transferring certificates,

which in this case is how the identity is established.

As per claim 11, the applicant argues that Furman US 5,483,653 and Boyles US

6,738,901 do not teach charging for jobs that were actually printed. The applicant argues

that Furman does not show a status screen. The examiner argues that Furman does show

a status screen (resulting display) in Col 4 lines 24 of Furman. However this is a moot

point as no status screen is actually claimed. However the examiner points out that it is

inherent that the printer communicate with the server, otherwise the server would have no

way of telling if the job was printed. Furman clearly illustrates that the display will

indicate whether the job was printed. The applicant further argues that Boyle does not

teach a server that charges for copies printed. The examiner again argues that it is

inherent that the printer or copier communicate with the server, in this case to indicate the

number of copies made, and thus incurring expenses. It is to be assumed in all cases, that

the invention, or device, works properly. In the case when the device working properly

copies made, or pages printed will be the "actual" number of copies.

As per claims 18, and 24 the applicant has sufficiently broadened claim 18 as to make the

claim not allowable. The claim, even in its entirety, is now believed not to be in

condition for allowance, and the rejection of claims 18 and 24 is included below.

Please see below for rejection of all other claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making
and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
contemplated by the inventor of carrying out his invention.

Claims 1, 12, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention.

As per claim 1, support for the recitation of "the printer not having the identity unit the

identity is given" cannot be found in the instant specification.

As per claim 12, support for the recitation of "directly" cannot be found in the instant

specification.

As per claim 30, support for "the printer not having the identity prior to the document

distribution" cannot be found in the instant specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

Claims 26 and 27 recite the limitation "the remote site". There is insufficient antecedent

basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an
international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by DeBry US 6,385,728.

As per claim 12,

1 DeBry teaches a method using a printer to distribute a document stored on a server, the

server being connected to a network, (Col 5 lines 34-39). DeBry teaches using at least

one cryptographic key to establish itself with the server, (Will Call certificate with key)

(Col 7 lines 40-49). DeBry teaches using the printer to decrypt and encrypted document

from the network, (Col 10 lines 18-21). DeBry teaches the printer prints a decrypted

document, (Col 10 lines 42-44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or
described as set forth in section 102 of this title, if the differences between the subject
matter sought to be patented and the prior art are such that the subject matter as a whole
would have been obvious at the time the invention was made to a person having ordinary
skill in the art to which said subject matter pertains. Patentability shall not be negatived
by the manner in which the invention was made.

Claims 1, 3, 4, 5, 6, 9, 10, 13, 15, 16, 19, 23 are rejected under 35 U.S.C. 103(a) as

being unpatentable over DeBry US 6,385,728 in view of Mandelbaum US 5,552,897

As per claims 1, 3, 16, 19 DeBry teaches a method using a printer to distribute a

document stored on a server, the server being connected to a network, (Col 5 lines 34-

39). DeBry teaches using at least one cryptographic key to establish itself with the

server, (Will Call certificate with key) (Col 7 lines 40-49). DeBry teaches using the

printer to decrypt and encrypted document from the network, (Col 10 lines 18-21).

DeBry teaches the printer prints a decrypted document, (Col 10 lines 42-44).

DeBry does not disclose using a smart card with the printer.

Mandelbaum teaches use of a smart card interface with a printer, in which the smart card

sends a message including a key, to the printer, (Col 4 lines 18-23). It would have been

obvious to one of ordinary skill in the art to use the smart card to Mandebaum with the

key of DeBry because the smart card enhances security and eliminates the chance of a

network attack.

As per claims 4, and 15 Debry does not disclose a smart card.

Mandelbaum discloses a smart card reader with a printer (facsimile) where the smart card

performs decryption for the printer, (Col 3 lines 35-40, 60-64).

It would be obvious to combine Mandelbaum's smart card with the modified DeBry

because the smart card provides secure encryption keys.

As per claim 5, DeBry teaches the printer is used to perform decryption, (Col 10 lines 42-

44).

As per claim 6, Debry teaches ordering the document prior to establishing a printer

identity, (Col 9 lines 37-40).

As per claim 9, DeBry teaches using at least one cryptographic key to authenticate the

printer prior to ordering the document, (Col 9 lines 51-61).

As per claim 10, 23 DeBry teaches using the printer to render (print) the decrypted

document, (Col 10 lines 42-44).

As per claim 13, DeBry teaches a client placing an order, (Col 6 lines 10-14).

Claims 2, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

DeBry US 6,385,728 in view of Mandelbaum US 5,552,897 in view of Furman US

5,483,653.

2. As per claim 2,and 22 DeBry as modified above, discloses sending an encrypted

document to a printer. DeBry does not disclose a message that indicates the number of

copies to be printed.

Furman discloses a message send with a document (job ticket) that indicates the number

of copies to be printed, where the printer prints the number of document copies indicated

in the message, (Col 6 lines 26-31, Col 7 lines 7-12, 32-35, Fig 3).

It would be obvious to modify DeBry's encryption of documents with Furman's printer

instructions because it provides the printer with needed instruction.

Claims 11, and 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over

DeBry US 6,385,728 in view of Mandelbaum US 5,552,897

in view of Furman US 5,483,653 in view of Boyles's US 6,738,901

As per claim 11, and 21, It would be obvious that DeBry-Mandelbaum combination disclosed printer would contain a status display. DeBry-Mandelbaum does not disclose that the display shows the status of the copies printed.

Furman discloses that the user can determine the status of printing through the server, (Col 4 lines 20-24).

It would be obvious to modify DeBry-Mandelbaum's print system with Furman's status screen because it provides lets the user know when his print jobs are complete.

Boyles teaches a network printer that registers a cost with a server for every copy printed, (Col 9 lines 18-21).

It would have been obvious for one of ordinary skill in the art to modify the previous combination with Boyles charging because it allows for a more versatile economic model for DRM.

Claim 17, is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Furman US 5,483,653 in view of Boyles's US 6,738,901

As per claim 17, It would be obvious that DeBry's disclosed printer would contain a status display. DeBry does not disclose that the display shows the status of the copies printed.

Furman discloses that the user can determine the status of printing through the server, (Col 4 lines 20-24).

It would be obvious to modify DeBry's print system with Furman's status screen because it provides lets the user know when his print jobs are complete.

Boyles teaches a network printer that registers a cost with a server for every copy printed, (Col 9 lines 18-21).

It would have been obvious for one of ordinary skill in the art to modify the previous combination with Boyles charging because it allows for a more versatile economic model for DRM.

Claims 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Mandelbaum US 5,552,897 in view of Peairs US 5,717,940.

As per claim 7, The previous DeBry-Mandelbaum does not disclose that the printer is used to order the document.

Peairs discloses that the printer may be used to order the document, (Col 3 lines 10-23).

As per claim 8, the previous DeBry-Mandelbaum combination does not disclose previewing at least one low quality document before ordering.

Peairs discloses a server that stores low quality document previews, (Col 4 lines 25-27, 57-59).

It would be obvious for one skilled in the art to modify DeBry-Mandelbaum print system, with de Peairs preview system because seeing a preview allows a user to easily select the document they are seeking.

Claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Peairs US 5,717,940.

As per claim 14, DeBry does not disclose previewing at least one low quality document before ordering.

Peairs discloses a server that stores low quality document previews, (Col 4 lines 25-27, 57-59).

It would be obvious for one skilled in the art to modify DeBry's printing system, with de Peairs preview system because seeing a preview allows a user to easily select the document they are seeking.

Claims 18, and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Davis US 5,568,552.

As per claims18, and 25-29 DeBry teaches using at least one cryptographic key to establish itself with the server, (Will Call certificate with key) (Col 7 lines 40-49).

DeBry does not teach authentication via means of an encrypted token.

Davis teaches a method of authentication comprising a first agent encrypting a token and sending it to a second agent wherein the second agent decrypted the token. The second agent encrypts the "decrypted token" with a key and sends it back to the first agent for comparison, (Col 8 lines 33-47).

It would have been obvious to one of ordinary skill in the art to modify the print system of Debry with the authentication system of Davis because it assures both agents are authentic and communications are secure.

As per claim 24 DeBry teaches using the printer to decrypt and encrypted document from the network, (Col 10 lines 18-21). DeBry teaches the printer prints a decrypted document, (Col 10 lines 42-44).

Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Mandelbaum US 5,552,897 in view of Choudury US 5,509074

As per claim 20, The previous DeBry-Mandelbaum combination does not disclose receiving an order from a printer keypad.

Choudhury discloses the printer has a keypad where the document may be obtained using the keypad, (Col 4 lines 26-30).

It would have been obvious to one of ordinary skill in the art to use the keypad of Choudhury in the printer system of Debry-Mandelbaum because ordering directly from the printer eliminates the need for other hardware.

Claims 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Savage US 6,442,687

As per claim 31, DeBry teaches using at least one cryptographic key to establish itself with the server, (Will Call certificate with key) (Col 7 lines 40-49).

DeBry does not teach a timeout period.

Savage teaches that if a response is not received within a specific period of time, communications are terminated, (Col 8 lines 26-32).

It would have been obvious to one of ordinary skill in the art to modify the DeBry print

system with the timeout method of Savage because the timeout decreases the threat of a

security breach.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Christopher J. Brown whose telephone number is

(571)272-3833. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gregory Morse can be reached on (571)272-3838. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Christopher J. Brown   9/20/05

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